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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
KATCHEVES, BASIL S	

ART UNIT	PAPER NUMBER
3635	

NOTIFICATION DATE	DELIVERY MODE
08/17/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mike.furr@bakerbotts.com
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Office Action Summary

Application No.

10/729,611

Applicant(s)

ANDERSON, MALCOLM WALTER

Examiner

Basil Katcheves

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,10,13-56,58 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-9,11,12,57,59-61 and 63-72 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-12 and 57-72 in the reply filed on 6/13/07 is acknowledged. The traversal is on the ground(s) that there is some overlap on scope. This is not found persuasive because the method and apparatus claimed are different from those elected. In addition, a phone call was made to David Wille on 8/9/07 regarding a species election which was not elected by the applicant in the paper dated 6/13/07. During the phone conversation Mr. Wille elected claims 1, 3, 4, 6-9, 11, 12, 57, 59-61, 63-72. These claims are examined below.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of tubular elements must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 4 and 61, the phrase "washer like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,835,525 to King, Jr.

Regarding claim 1, King discloses a bolt protection apparatus having a first means for surrounding a bolt (fig. 1: 10), and a second means (fig. 6: 102) for assisting in fixing the first means.

Regarding claim 3, King discloses both means as integral.

Regarding claim 4, King discloses the first means as tubular and the second means as washer like.

Regarding claims 6, 7, King discloses the sleeve as being made of a metal that resists corrosion from chemicals in the wood (abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 11, 12, 64, 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,835,525 to King Jr. in view of U.S. Patent No. 3,541,917 to VanDouwen.

Regarding claims 8, 9, 11, 12, 64, 65, King discloses the bolt sleeve as made of a rigid material but not made of plastic. VanDouwen discloses a plastic surrounding a bolt (column 2, line 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify King by using a plastic sleeve since the object of the King invention is to prevent corrosion to the bolt, plastic is a functional equivalent since it does not corrode and is commonly found and used as fasteners or in applications where corrosion resistance is needed.

Claims 57, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,835,525 to King Jr.

Regarding claim 57, King discloses a bolt protection apparatus having a first means for surrounding a bolt (fig. 1: 10), and a second means (fig. 6: 102) for assisting in fixing the first means, the bolt (14) passing through the sleeve. However, King does not particularly disclose the work piece (P) as being lumber. It would have been

obvious to one having ordinary skill in the art at the time the invention was made to use lumber as the workpiece since King discloses the workpiece since chemically treated lumber is typically used in the marine (abstract) environment.

Regarding claim 66, King discloses the sleeve as retarding corrosion (abstract).

Claims 59, 60, 61, 63, 67, 68, 69, 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,835,525 to King Jr. in view of U.S. Patent No. 5,379,563 to Tinsley.

Regarding claims 57, 59, King does not disclose the use of the fastening system where a bolt is attached to a foundation. Tinsley discloses a system having a bolt fastened to a foundation (fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the bolt and sleeve system of King in a foundation, since foundations commonly use a bolted connection. King does not particularly disclose the work piece (P) as being lumber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use lumber as the workpiece since King discloses the workpiece since chemically treated lumber is typically used in the marine (abstract) environment.

Regarding claim 60, King discloses the sleeve as tubular.

Regarding claim 61, King discloses the washer end of the tube as being perpendicular.

Regarding claim 63, King discloses the tube in segments (fig. 5).

Regarding claim 67, 72, King discloses the sleeve as retarding corrosion (abstract).

Regarding claim 68, 69, 70, King discloses a washer and nut over the end (fig. 1: 12 & 16), the washer preventing the nut from contacting the lumber (fig. 4).

Regarding claim 71, King discloses the claimed invention except for two washers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a second washer, since it has been held that a mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to bolt sleeves in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (571) 272-6842.

BK


Basil Katcheves

8/13/07

Examiner AU 3635